A6

30.(Amended) The additive package of claim 29 wherein said block copolymer is a propylene oxide block copolymer.

35.(Amended) The additive package of claim 33 wherein said surfactant stabilizer is an aliphatic hydrocarbon nonionic surfactant or xylene modified polyester surfactant.

36.(Amended) The additive package of claim 32 wherein said wetting agent is comprised of a decyne diol nonfoaming wetter.

A7

37.(Amended) The Additive package of claim 32 wherein said dinonylphenol ethoxylate is a dinonylphenol ethoxylate.

38.(Amended) The additive package of claim 32 wherein said amine othoxilate is amine othoxilate.

Remarks

Claims 9, 10, 12, 14, 15, 16, 29, 30, 35, 36, 37 and 38 were amended to remove all trademark and/or tradenames pursuant to paragraph 3 of the Office Action. Claim 20 was amended to add the element of "purified water" as discussed in the specification and to traverse the §103 rejection. No new matter was introduced.

The 35 USC §102 Second Paragraph Rejections

The examiner states that "[C]laims 1-45 are rejected because the claims lack proportions. In the absence of proportions, the metes and bounds of the claims cannot be determined." (OA at page 3, first full paragraph.) However, the examiner has failed to establish a *prima facie* case of indefiniteness.

The examiner appears to be arguing that since the claims do not contain the "proportions" which are stated in the specification, that the claims are not allowable. However, the claims must be analyzed in light of the disclosure. As stated in the MPEP:

> "[D]efiniteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." (MPEP §2173.02.)

The examiner appears to be using the specification as a sword to prevent the allowance of the claims which do not recite all the limitations from the specification. However, the use of the specification as a sword is not permitted:

"[T]he specification must be sufficiently explicit and complete to enable one skilled in the art to practice the invention, while a claim defines only that which the patentee regards as his invention. 35 U.S.C. §112. The claim, not the specification, measures the invention. (Case cited). The argument that claim 1 ***must include a limitation found in the specification is legally unsound***." *Raytheon Co. v. Roper Corp.*, 220 USPQ 592, 597 (Fed. Circ. 1983), *cert. denied*, 469 U.S. 835 (1984), (Emphasis this author's).

Further, the Federal Circuit overturned a Patent Office Board of Appeals for finding indefiniteness due to claims not being limited to compositions disclosed in the specification:

> "The board also found indefiniteness in the fact that the claims were not limited to compositions disclosed or suggested by appellant's specification, and would cover 'a host of materials produced in any possible manner, including synthetically, which are neither taught nor represented by the specific materials actually formed in appellant's examples.' Appellant does not dispute that the claims are as broad as the board indicated. This fact, however, while very important in assessing the sufficiency of appellant's disclosure to see if it will support such broad coverage, **is entirely irrelevant to the issue of definiteness...**" *In re Fisher*, 166 USPQ 18, 23 (Fed. Circ.1970), (Emphasis this author's).

Therefore, the lack of "proportions", which are found in the specification, are entirely irrelevant to the issue of definiteness, and thus, the examiner has failed to establish a *prima facie* case for indefiniteness for claims 1-45.

The 35 USC §103 Rejection

Claims 1-8, 11, 13, 17-28 and 32-34 are rejected under 35 USC §103(a) as being unpatentable over Dubin (US 5,284,492). Claims 39 and 42 are rejected under 35 USC §103(a) as being unpatentable over Dubin further in view of Genova (US 5,259,851). Claims 40 and 41 are rejected under 35 USC §103(a) as being unpatentable over Dubin and Genova further in view of Wenzel(US 4,002,435). Claims 43 and 44 are rejected under 35 USC §103(a) as being unpatentable over Dubin and Genova further in view of Schwab (US 5,669,938). Claim 45 is rejected under 35 USC §103(a) as being unpatentable over Dubin in view of European Patent Application 475 620 ("EPA").

Argument

The threshold issue under Section 103 is whether the Examiner has established a *prima facie* case for obviousness.

> "The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 5 USPQ2d 1596, 1598 (CAFC 1988) (citations omitted).

In establishing a *prima facie* case of obviousness, the PTO "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention". *Id.* at 1600. Rather, "[T]he test is whether the claimed invention as a whole, in light of all of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made". *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 199 (CAFC 1983).

Applicant respectfully suggests the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, one of the criteria that must be met is that "the prior art reference (or references when combined) **must teach or suggest all claim limitations**. The teaching or suggestion to make the claimed combination must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)." MPEP Chapter 2142. (Emphasis this author's.)

Claim 1 of the instant application has the limitation of a "purified water". Dubin makes no reference or suggests purified water. Further, purified water is discussed in the instant application at page 3, lines 19-26 as preferably having certain maximum levels of calcium ions, magnesium ions and silicon. Dubin neither has nor suggests said maximum levels of calcium ions, magnesium ions and silicon. Thus, the examiner has failed to establish a prima facie case of indefiniteness with respect to claims 1-8, 11, 13, 17-19, 20(Amended), 21-28 and 32-34.

With respect to the rejection of claims 39 and 42 as being unpatentable over Dubin in view of Genova, neither Dubin nor Genova contain the limitation nor suggest the limitation of "purified water", thus the examiner has failed to establish a *prima facie* case of obviousness.

With respect to the rejection of claims 40 and 41 as being unpatentable over Dubin and Genova in view of Wenzel, neither Dubin, Genova nor Wenzel contain the limitation nor suggest the limitation of "purified water", thus the examiner has failed to establish a *prima facie* case of obviousness.

With respect to the rejection of claims 43 and 44 as being unpatentable over Dubin and Genova in view of Schwab, neither Dubin, Genova nor Schwab contain the limitation nor suggest the limitation of "purified water", thus the examiner has failed to establish a *prima facie* case of obviousness.

With respect to the rejection of claim 45 as being unpatentable over Dubin and Genova in view of the EPA, neither Dubin, Genova nor the EPA contain the limitation nor suggest the limitation of "purified water", thus the examiner has failed to establish a *prima facie* case of obviousness.

A fee of $1,280.00 is provided along with the concurrently filed Petition to Revive Unintentionally Abandoned Application.

On the basis of the above remarks, early consideration of this application and early allowance are respectfully requested.

Respectfully,

By:_____

Michael A. Blake
Attorney for Applicant
Reg. No. 42,333

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Sierra Patent Group
P.O. Box 6149
295 Highway 50, Suite 20
Stateline, Nevada 89449

Telephone: (775) 586-9500
Facsimile: (775) 586-9550